

Atty Matter No. 0276492
Atty Reference No. 23521-0107

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re Patent Application of:)
Vassilios Papadopoulos et al.)
Application No. 09/047,652)
Filed: March 25, 1998) Group Art Unit: 1642
For: PERIPHERAL-TYPE BENZODIAZEPINE)
RECEPTOR: A TOOL FOR DETECTION,)
DIAGNOSIS, PROGNOSIS, AND)
TREATMENT OF HUMAN BREAST)
CANCER) Examiner: M. Davis
02/20/01

REPLY PURSUANT TO OFFICIAL ACTION
IMPROPERLY HOLDING OCTOBER 12, 2000 REPLY NON-RESPONSIVE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Reply is responsive to the January 18, 2001 letter. In response to this Official Action, which this should not be necessary, kindly cancel Claims 58-62. As a result of this amendment, all the current are directed to an isolated, biogenetically pure antisense oligonucleotide that possesses a structure complementary to PBR receptor DNA sequences, and which inhibits the expression of the PBR gene.

In the most recent Official Action, the Examiner improperly held Applicants' October 12, 2000 Reply non-responsive. Particularly, she asserted that all the claims submitted with the most recent Reply are directed to a non-elected invention. However, this is not the case.

Indeed, Applicants' previous Reply dated December 15, 1999 contained Claim 50 directed to an antisense oligo complementary to PBR RNA or DNA that inhibits the expression of PBR. Moreover, the claim was treated on the merits and rejected in the April 12, 2000 Official Action under §112, first paragraph, and under §103 based on prior art.

In response to such rejection, Applicants narrowed their claims such that they are directed to antisense oligos complementary to PBR sequences having express support in the disclosure. Moreover, when they submitted such amendments, Applicants were not under

REPLY TO OFFICIAL ACTION
U.S. Serial No. 09/047,652
Page 2

final rejection. Accordingly, it is not seen how the previous Amendment was improper as quite clearly, Applicants submitted a Reply with numerous claims corresponding to an invention previously elected and treated on the merits. While it is understood that the Examiner perhaps did not search for these specific sequences, they were part of the disclosure. Also, the disclosure made clear that these sequences correspond to PBR (see pp. 15-16 of the application).

Accordingly, in construing the claims, it should have been apparent that antisense oligonucleotides corresponding to these sequences constituted subject matter directed to an invention already searched and examined. Indeed, it is unclear how the Examiner could have construed the claimed PBR antisense oligos absent a search of SEQ ID NOS:1 or 2.

However, in any event, Applicants did not submit an improper Reply.

If the Examiner has any questions with respect to this application, please contact the undersigned attorney of record at the telephone number listed below.

Respectfully submitted,

PILLSBURY WINTHROP L.L.P.

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Date: February 20, 2001

TOTAL P.05

02/20/01 TUE 17:59 [TX/RX NO 8940]

FEB-20-2001 17:00

202 822 0944 P.01/05

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FEB 21 2001

GROUP 1600

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02/20/01

-->>> USPTO:

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In re PATENT APPLICATION of

Inventor(s) Vassilios Papadopoulos et al.
Appln. No. 09/047,652

Group Art Unit: 1642
Examiner: M. Davis

series code ? ↑ serial no.
Filed: March 25, 1998

Atty. Dkt. PM 0276492
M#

TITLE: Peripheral-Type Benzodiazepine Receptor: A Tool for Detection, Diagnosis, Prognosis, and Treatment of Human Breast Cancer

Date: February 20, 2001

Name or type of signed paper being transmitted:
Reply to Official Action

MESSAGE:

Please see the attached Reply to the January 18, 2001 Official Action.

Thank you.

(ATTN: Atty/Sec.: Transmit only one paper herewith. For papers not acceptable by fax, see back side or IAN Forms Directory PAT-286 Rear. Do not file originals but fasten them in our file (left side) with this sheet and fax receipt on top. Do NOT send the originals nor a confirmation copy to the PTO.)

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I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Name Robin L. Teskin

Sig. Robin L. Teskin

Date February 20, 2001

082137/0276492
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PAT-286 7/99

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PILSBURY WINTHROP

PATENT AND TRADEMARK OFFICE

202 822 0944 P.02/05

PATENT APPLICATION

Inventor(s): Vassilios Papadopoulos et al.
 Appl. No.: 09 | 047,652
 Series Code ↑ | Serial No. ↑

Filed: March 25, 1998

Hon. Commissioner of Patents
Washington, D.C. 20231

Group Art Unit: 1642
 Examiner: M. Davis
 Atty. Dkt. PM 0276492 | 23521-0107
 M# Client Ref

Appl. Title: Peripheral-Type Benzodiazepine Receptor, A Tool for Detection, Diagnosis, Prognosis, and Treatment of Human Breast Cancer

Sir:

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FEB 21 2001

REPLY/AMENDMENT/LETTER GROUP 1600

Date: February 20, 2001

This is a reply/amendment/letter in the above-identified application and includes the herewith attachment of same date and subject which is incorporated hereinto by reference and the signature below is treated as the signature to the attachment in absence of a signature thereto.

FEE REQUIREMENTS FOR CLAIMS AS AMENDED

1. Small Entity claim						
A. <input type="checkbox"/> NOT made	For B & C					
B. <input type="checkbox"/> Withdrawn	See Required					
C. <input type="checkbox"/> made herewith	Separate Paper	(Pat-256)				
D. <input checked="" type="checkbox"/> made previously						
2. Total Effective Claims	**minus	0	0	x \$18/\$9 =	+ \$0	103/203
3. Independent Claims	***minus	0	0	x \$80/\$40 =	+ \$0	102/202
4. If amendment enters proper multiple dependent claim(s) into this application for first time (leave blank if this is a reissue application)	add			+ \$270/\$135 =	+ \$0	104/204
5. Original due Date: February 18, 2001	<input type="checkbox"/> NONE					
6. Petition is hereby made to extend the original due date to cover the date this response is filed for which the requisite fee is attached	(1 mo)	\$110/\$55 =				115/215
	(2 mos)	\$390/\$195 =	+ \$0			116/216
	(3 mos)	\$890/\$445 =				117/217
	(Usable only for ≤ 2mo.OA --- 4 mos)	\$1390/\$695=				118/218
	(Usable only for 30 day/1mo.OA --- 5 mos)	\$1890/\$945=				128/228
7. Enter any previous extension fee paid since above original due date and subtract		- \$0				
8.	<u>Extension Fee Attached</u>		+ \$0			
9. If Terminal Disclaimer attached, add Rule 20(d) official fee		+ \$110/\$55	+ \$0			148/248
10. If IDS attached requires Official Fee under Rule 97 (c),	add	+ \$180	+ \$0			126
or if Rule 97(d) Request	add	+ \$180	+ \$0			126
11. After-Final Request Fee per rules 129(a) and 17(r)		+ \$710/355	+ \$0			146/246
12. No. of additional inventions for examination per Rule 129(b)		x \$710/355 ea	+ \$0			149/249
13. Request for Continued Examination (RCE)		+ \$710/355	+ \$0			1179/1279
14. Petition fee for			+ \$0			
15.	<u>TOTAL FEE ENCLOSED =</u>		<u>\$0</u>			

16. *If the entry in this space is less than entry in next space, the "Present Extra" result is "0".

17. **If the "Highest number previously paid for" in this space is less than 20, write "20" in this space.

18. ***If the "Highest number previously paid for" in this space is less than 3, write "3" in this space.

Our Deposit Account No. 03-3975)

(Our Order No. 082137 | 0276492

C# M#

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This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.

Query: Is appeal deadline now? If so, file Notice of Appeals separately.

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NOTE: File this cover sheet in duplicate with PTO receipt (PAT-103A) and attachments